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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,466	01/09/2002	Shirou Tanabe	500.25179CP5	3659
20457	7590	04/15/2005	EXAMINER	
ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-3873			TON, DANG T	
			ART UNIT	PAPER NUMBER
			2666	

DATE MAILED: 04/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/040,466	<b>Applicant(s)</b> TANABE ET AL.	
	<b>Examiner</b> DANG T TON	<b>Art Unit</b> 2666	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-13 is/are allowed.
- 6) ☒ Claim(s) 1-7 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 07/645,491.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/9/2002</u> . | 6) <input type="checkbox"/> Other: _____  |

1. The disclosure is objected to because of the following informalities: Applicant should provide a status of the copending application number 09/340,139 in the specification.

Appropriate correction is required.

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 5,740,156.

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

For claims 1-8, the claimed 1-7 of the patent number 5,740,156 disclose a packet switching system comprising:

a plurality of local units each accommodating a plurality of packet circuits, each of the local units including label conversion means, a self-routing switch and control means for performing call processing control in respect of a control packet, the label conversion means being operable to generate first routing information indicative of an output port of the self-routing switch depending upon a virtual channel identifier of a packet received from one of the packet circuits and the self routing switch being operable to effect self-routing of the packet based on the first routing information; and

a tandem unit including at least one self-routing switch for interconnecting the local units;

each of the local units further including means for setting, between the local unit and the tandem unit, the same virtual channel as that between the tandem unit and a destination local unit which is one of a remainder of the plurality of local units, with respect to a call to be transferred to the destination local unit through the tandem unit and means for inserting second routing information indicative of an output port of the self-routing switch of the tandem unit into

Art Unit: 2666

a packet to be transferred to the destination local unit through the tandem unit, whereby when a call control packet from one of the local units arrives at the tandem unit, the call control packet is transferred to the destination local unit based on the second routing information without undergoing call processing control ;

wherein each of the local units includes means for determining a virtual channel of a reception call when operating as the destination local unit for information transfer whereby different virtual channels are allotted to calls from a plurality of different local units so that logic connection is identified by only a virtual channel identifier (VCI) without resort to an originating local unit ;

a plurality of local units each accommodating a plurality of packet circuits, each of the local units including label conversion means, a self-routing switch and control means for performing call processing control in respect of a control packet, the label conversion means being operable to generate first routing information indicative of an output port of the self-routing switch depending upon a virtual channel identifier of a packet received from one of the packet circuits and the self-routing switch being operable to effect self-routing of the packet based on the first routing information; and

a tandem unit including at least one self-routing switch for interconnecting the local units through internal packet circuits;

each of the local units further including means for setting, between the local unit and the tandem unit, the same virtual channel as that between the tandem unit and a destination local unit which is one of a remainder of the plurality of local units, with respect to a call to be transferred to the destination local unit through the tandem unit and means for inserting second routing information indicative of an output port of the self-routing switch of the tandem unit into a packet to be transferred to the destination local unit through the tandem unit;

at least two of the plurality of local units, one of the at least two of the plurality of local units defining a by-pass route by way of the tandem unit and the other of the at least two of the plurality of local units defining them for an outgoing route on one of the packet circuits toward another switching system;

each of the at least two local units having means for storing the bandwidth assignment state with respect to the outgoing route and one of the internal packet circuits used for the by-pass route so that the local unit, when originating an outgoing route call, selects one of the outgoing route and the

Art Unit: 2666

by-pass route permissible for assignment ;

wherein each of the at least two local units has means operable to indicate the bandwidth assignment state in terms of at least one threshold value and when the bandwidth assignment on the outgoing route or the by-pass route becomes over or below the threshold value upon setting or release of the outgoing route call, inform of the change of the bandwidth assignment state to the other of the at least two local units ;

wherein the threshold value is different for the time that the outgoing route call setting is effected and the time that the outgoing route call release is effected ;

wherein desired one of the two local units transmits the bandwidth assignment state in respect of each outgoing route periodically to all of the other local units.

Note : see the claims 1-7 of the patent number 5,740,156.

Applicant's claims 1-8, merely broaden the scope of the claims 1-7 of the patent number 5,740,156 by eliminating the terms " second routing information" from the claim 1 and "at least two of the plurality of local units, one of the at least two of the plurality of local units defining a by-pass route by way of the tandem unit and the other



of the at least two of the plurality of local units defining them for an outgoing route on one of the packet circuits toward another switching system " from claim 4 of the claims 1-7 of the patent number 5,740,156 . It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re karlson, 136 USPQ 184 (CCPA). Also note Ex Parte Raine, 168 USPQ 375 (bd. App. 1969); omission of a reference element whose function is not need would be obvious to one skilled in the art.

4. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 14 line 16, " said local circuit" lacks antecedent basis because it is not known what the local circuit applicant is referring to.

5. Claims 9-13 are allowed.

6. Claim 14 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2666

Tanabe et al. ( 6,618,372 ; 6,005,867 ; and 5,999,537) and Sakurai et al. ( 5,043,979) are all cited to show systems which are considered pertinent to the claimed invention.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANG T TON whose telephone number is 571-272-3171. The examiner can normally be reached on MON-WED, 5:30 AM-6:00 PM and Thur 5:30-9:30 A.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RAO SEEMA can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. Ton

  
